

5 KEY TAKEAWAYS

Ethical Considerations in IP Investigations: Balancing Effectiveness and Integrity

Kilpatrick's **Chris Bussert** recently joined a panel discussing "**Ethical Considerations in IP Investigations: Balancing Effectiveness and Integrity**" at the **2025 INTA Leadership Meeting**. The panel examined ethical challenges associated with surveillance, online monitoring, the use of "incomplete" information when dealing with a trademark owner, the use of investigators, and related concerns. Panelists provided guidance on ensuring that investigatory efforts comply with ethical and legal standards while effectively gathering important information.

Chris' key takeaways from the discussion include:

1

Thoroughly vet the investigator as to experience and credentials including in generating necessary reports, declarations or affidavits, and testifying, and assess any reluctance the investigator exhibits in undertaking any of these actions. The investigator's communication skills should be assessed as well. Verify that the investigator is licensed in the jurisdiction in which the investigation will take place. Oftentimes, former members of federal and state law enforcement agencies with a background in investigations serve as highly credible witnesses.

2

Local ethics rules, disciplinary rulings and opinions, and case law should be closely scrutinized before embarking on a pretext investigation, including in the states where the lawyer is admitted to practice, where the case is pending, and where the investigation will take place. As the decisions discussed above make clear, judicial precedent interpreting the applicable ethical rules varies from locale to locale and should be carefully considered in developing a strategy for the use of pretext.

3

The timing of any investigation is important as well (non litigation, pre litigation settings, litigation instituted but service not yet achieved, etc.). Once litigation has been instituted and all parties served, courts are far more likely to apply strictly the rules against communicating with persons represented by counsel and/or that are unrepresented.

4

Verifying and documenting normal business practices and transactions in the ordinary course of business with members of the general public is usually permitted even if a complex ruse is employed to ascertain that information. However, a ruse involving an individual posing as a professional to obtain information generally accessible or available only by highly trained professionals (such as a physician) is problematic and can result in exclusion of any information obtained and significant sanctions by courts.

5

Covertly audiotaping or videotaping normal business practices and transactions is probably acceptable even after litigation is commenced, although before doing so the law of applicable jurisdiction should be reviewed to ascertain whether making recordings without permission of any individual being recorded is allowed. Even in jurisdictions where audiotaping and videotaping is permissible, courts are more likely to significantly scrutinize recordings obtained after litigation has been instituted and/or where the purpose of the recording is to document responses to leading questions or secure admissions.